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EXAMINER

TUCKER, PHILIP C

ART UNIT

PAPER NUMBER

1712

DATE MAILED: 07/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

746322

Applicant(s)

HUGHES

Examiner

P. TUCKER

Group Art Unit

1712

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on 4/28/03
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-19, 21-23, 25-32 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☒ Claim(s) 25 is/are allowed.
- ☒ Claim(s) 1-19, 21-23, 26-32 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
 - ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

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DETAILED ACTION

Claim Objections

1. Claim 1 objected to because of the following informalities: In claim 1, line 2, the typographical error "poation" appears. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 26-32 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Independent claim 26 contains several issues of new matter, in line 6, R being cycloalkyl or bicycloalkyl is new matter, in line 8, R being an aryl or heteroaryl group is new matter, in line 10, R being heteroaralkyl is new matter, in lines 16-18, 1 to 12 carbon atoms is new matter, in line 20, 2-12 carbon atoms is new matter, In line 22, the ring

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structure contains new matter not disclosed by the specification, such as a seven membered ring the residues of line 31 are new matter, the ring structures of lines 37-39 are new matter, the 1-12 or 3-12 carbon atoms of lines 48-50 is new matter, the groups of lines 54 and 55 constitute new matter, the cyclic groups of line 60 constitute new matter, the groups of the last line of the claim constitute new matter. Such new matter was not supported by the specification as originally filed. Dependent claims fall herewith. Other new matter may exist in the claim which was not identified above, and should be corrected appropriately.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-19 and 26-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, a structure is shown without a definition for R, R1 and R2, and contains a chlorine atom in the 9-position, which differs from applicants claimed substituents. Dependent claims fall herewith.

In claim 26, line 8, the aryl or heteroaryl groups cannot form an alkoxy group. In lines 54 and 55, alkenyl, alkenyloxy, alkynyl and alkynyloxy groups cannot contain 1 carbon atom.

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Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

7. Claims 21-23 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 98/42695.

See the compound on page 11 (Example 7) and the general formula I on pages 3-4.

8. Claims 21 and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Tanizawa et al (6197225 B1).

Tanizawa teaches a naphthopyran compound which may contain a halogen substituent R4 in the 7 or 9 position, and exemplifies such a compound (see example 41 in column 76, and column 6, line 64 - column 7, line 12). R2 and R3 can be alkoxy substituted phenyl groups (column 3, lines 13-36). The present invention is thus anticipated by Tanizawa.

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9. Claim 25 is allowable over the art of record.

10. Applicants amendments and arguments have been considered but are not deemed fully persuasive. The amendment such that one of R7 and R9 is fluoro, and the other is alkoxy distinguishes over the prior art of record. Such distinction does not exist in claim 21, and thus this claim and those dependent thereon are still rejected under 35 USC 102. Applicants amendment also introduces new issues under 35 USC 112 as outlined above.

In claim 23, it is noted that applicant is claiming that at least one of R1 and R2 are a substituted phenyl having a substituent. However, in view of the specification and the structure in claim 21, it is believed that applicant wanted to limit the definition to the substituents, and not phenyl bearing the substituents, since this would create biphenyl groups, not supported by the specification. On page 12, line 3 of the specification the word "sing" appears instead of "ring".

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip Tucker whose telephone number is (703) 308-0529. The examiner's normal working hours are 7:30am-4:00pm, Monday-Friday. If necessary SPE Robert Dawson may be contacted at 703-308-2340. For inquiries of a general nature call the receptionist at 703-308-0651. The group FAX no. is 703-872-9310. The **after final** fax no. Is 703-872-9311.

PCT-2699
July 1, 2003


PHILIP C. TUCKER
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